

DISCUSSION OF THE AMENDMENT

Claims 2-4, 10-12 and 15-17 have each been amended by replacing "Solvesso® 150" with --a hydrocarbon fluid having an aromatics content >99 volume% according to ASTM D 1319, a color of Saybolt 30 according to ASTM D 156, an initial boiling point of 186°C and a dry point of 204 °C according to ASTM D 86, a flash point of 66°C according to ASTM D 56, a Kauri-butanol value of 94 according to ASTM D 1133, and a specific gravity of 0.897 15.6°C/15.6°C according to ASTM D 4052--, as suggested by the Examiner.

Claim 7 has been amended to depend on Claim 4 only. New Claim 30 has been added to claim subject matter deleted from the amendment to Claim 7.

No new matter is believed to have been added by the above amendment. Claims 1-30 are now pending in the application.

REMARKS

The rejections under 35 U.S.C. § 103(a) of Claims 1, 5, 8, 9, 13, 14, 18-20, 25, 26, and 28 as unpatentable over U.S. 5,036,134 (Kunz et al), and of Claims 1, 5, 8, 9, 13, 14, and 25-29 as unpatentable over U.S. 6,048,936 (Epple et al), each one of Kunz et al and Epple et al in view of JP 04-036364 (JP '364), are respectfully traversed.

Kunz et al and Epple et al are examples of prior art processes, described in the specification under "Description of the Related Art" beginning at page 1, line 11, relating to the production of resins by free-radical polymerization of polyacrylate-producing monomers in the presence of a polyester. Such resins and processes for producing them have not been fully successful. For example, the low molecular weight of the polyesters, owing to relatively high OH and acid numbers, leads to poor adhesion properties on substrates and poorer mechanical properties such as flexibility. Applicants, however, make no representation of particular problems associated with Kunz et al and Epple et al, *per se*.

The prior art, however, does not disclose the use of dicidol-containing polyester to make such resins, as described in the specification at page 2, line 13.

Present Claim 1 recites a polymer-modified resin, comprising I) at least one hydroxy-functional or carboxy-functional polyester, and II) at least one glycidyl-containing polyacrylate, wherein said polyester I comprises an alcohol component containing of from 0.5 to 80 mol% of a dicidol fraction, and wherein said resin is obtained by free-radical polymerization of the starting component(s) for the preparation of said polyacrylate II in the presence of the polyester I in at least one organic solvent.

JP '364 discloses a coating material asserted to be excellent in suitability for a wet ink, adhesiveness, and boiling water resistance by using as the constituent a polyester resin which has a specified viscosity and is formed from a specified glycol component and a dicarboxylic acid component consisting mainly of an aromatic dicarboxylic acid, wherein the

glycol component comprises 50-100 mol% of a particular tricyclodecanedimethanol derivative having formula 1 therein.

The Examiner relies on JP '364 as suggesting the incorporation of dicidol into the polyesters of Kunz et al or Epple et al, the motivation being that "the adherence of polyesters is improved."

In reply, JP '364 does **not** disclose any **improvement** in adherence, let alone that such an improvement is due exclusively to the presence of the above-discussed glycol of formula 1. Rather, JP '364 simply discloses that adherence is excellent for their coating material. In other words, JP '364 does not disclose that their coating material provides a better coating material than one obtained using a different glycol. In addition, JP '364 discloses and suggests nothing with regard to their polyester resin combined with a glycidyl-containing polyacrylate, let alone said polyacrylate prepared by free-radical polymerization of its starting components in the presence of their polyester in at least one organic solvent. At best, JP '364 is evidence that the glycol of their formula 1 has been used to make polyesters *per se* and that it would have been obvious to try this glycol.

"Obvious to try" has long been held not to constitute obviousness. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988) (**copy enclosed**). A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out. *In re Deuel*, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1216 (Fed. Cir. 1995) (**copy enclosed**).

The Examiner finds that the arguments of patentability made in the previous response are now moot in view of the new ground of rejection. However, Applicants previously relied on the comparative data of record to demonstrate the superiority of various properties when the presently-recited dicidol is used to make the polyester. This data is still relevant, and

should have been responded to by the Examiner. For the Examiner's convenience, the comparative data is described again below.

The results for the comparative data are shown in the table at page 15 of the specification, reproduced below, wherein the properties of gloss, adhesion, pencil hardness and MEK test and a soot test, were carried out. The differences are manifest.

	Coating material from A), Dicidol-containing	Coating material from B), Dicidol-free
Gloss (60°)	93	82
Adhesion	GT 0	GT 1
Pencil hardness	H	HB-F
MEK test (double rubs)	> 100	50
Soot test (15', 80°C)	0 - 1	1

Thus, even if the above-applied combination of prior art suggested an improvement in adhesion, this prior art discloses and suggests nothing with regard to the other properties for which superiority has been shown. It is error not to consider these results.

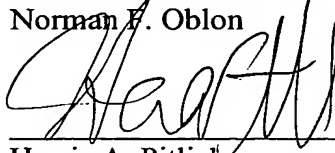
For all the above reasons, it is respectfully requested that the rejections over prior art be withdrawn.

The rejection of Claims 2-4, 7, 10-12 and 15-17 under 35 U.S.C. § 112, second paragraph, in the recital of the trademark "Solvesso®", is respectfully traversed. While Applicants maintain that the above-quoted term is well-understood in this art when preceding the term "150", nevertheless, the claims have been amended as suggested by the Examiner at the last sentence of paragraph 8 of the Office Action. Accordingly, it is respectfully requested that this rejection be withdrawn.

Applicants gratefully acknowledge the Examiner's indication of allowability of the subject matter of Claims 6 and 21-24 unconditionally, and of Claims 2-4, 7, 10-12, and 15-17 if rewritten to overcome the above-discussed rejection under 35 U.S.C. § 112, second paragraph. Nevertheless, Applicants respectfully submit that all of the presently-pending claims in this application are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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